

REMARKS

Claims 1-9 have been examined on their merits.

Applicants herein amend claims 1, 2 and 4 to clarify that the supplier information is acquired prior to selecting a supplier. Applicant submit that the amendments to claims 1, 2 and 4 do not present any new issues requiring further search by the Examiner, and reduce issues for appeal. Entry and consideration of the amendments to claims 1, 2 and 4 is respectfully requested.

Claims 1-9 are all the claims presently pending in the application.

1. Claims 1, 2, 4, 5 and 7-9 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Venkatesan *et al.* (U.S. Patent No. 6,282,550). Applicants respectfully traverse the rejection of claims 1, 2, 4, 5 and 7-9 for at least the reasons discussed below.

Venkatesan *et al.* disclose, *inter alia*, a method and system for ordering synthesized peptides, oligonucleotides or peptide nucleic acids from various suppliers. As clearly illustrated in Figure 2A (at step 8) and Figure 3A (at step 19), the customer requests a particular synthesized strand of peptide, oligonucleotide or peptide nucleic acid from one or more suppliers, and the suppliers respond back to the customer in the affirmative if they can provide the synthesized strand. However, Venkatesan *et al.* fail to teach or suggest a step of at least acquiring a time when a supplier can supply a particular service and making a selection of a supplier based on at least that criteria, as recited in claim 1. In the February 11, 2005 Non-Final Office Action, the Patent Office cites col. 10, lines 27-37 and 50-52 of Venkatesan *et al.* as allegedly teaching this recitation. However, a fair reading of the cited passage does not support the Patent Office's

interpretation. The cited passages disclose the ordering of a synthesized strand of peptide, oligonucleotide or peptide nucleic acid and the searching for suppliers (within a database) that can supply the desired synthesized strand of peptide, oligonucleotide or peptide nucleic acid. There is no disclosure of acquiring a time for when the desired synthesized strand of peptide, oligonucleotide or peptide nucleic acid can be delivered. The selection of synthesized strand suppliers is discussed, but there is no disclosure that the time when a supplier can supply a requested synthesized strand is considered to be a selection criterion. Moreover, the language of claim 1 is directed towards supplying a service (*e.g.*, interpreting medical tests), whereas the disclosure of Venkatesan *et al.* is directed to supplying a desired product.

In the September 23, 2005 Final Office Action, the Patent Office alleges that column 5, lines 27-37 of Venkatesan *et al.* disclose “acquiring supplier information concerning at least a time when each of said supplier can supply said service via network [sic].” Column 5, lines 27-37 of Venkatesan *et al.* is reproduced below:

A preferred embodiment of this invention is shown in FIG. 1. In step (1), the Customer desires to purchase a certain synthesized strand, said strand may be an ON, PT or PNA, and the Customer accesses a central Database, which includes Supplier Capability Information from a plurality of different Suppliers. In step (2), the Customer then enters the details of the desired synthesized strand in the Request. In step (3), the Database is searched, preferably automatically, for any and all Suppliers with Supplier Capability Information which meets the Request. Applicants fail to see any disclosure, explicit or otherwise, in the above-cited text that states that supplier information is acquired that concerns at least a time when each supplier can supply the desired synthesized strand.

In the September 23, 2005 Final Office Action, the Patent Office alleges that column 5, lines 50-52 of Venkatesan *et al.* disclose “acquiring supplier information concerning at least a

time when each of said supplier can supply said service via network [sic].” Column 5, lines 46-52 of Venkatesan *et al.* is reproduced below:

In this embodiment, the Supplier and Provider enter into an agreement in step (5), in which the Supplier agrees to disclose the Supplier Capability Information, preferably including the Supplier's pricing algorithm to the Provider in step (6) and the Provider stores the Supplier Capability Information in a Database which is connected to a Network, preferably the Internet in step (7).

Again, Applicants fail to see any disclosure, explicit or otherwise, in the above-cited text that states that supplier information is acquired that concerns at least a time when each supplier can supply the desired synthesized strand.

In the September 23, 2005 Final Office Action, the Patent Office alleges that column 7, lines 3-6 of Venkatesan *et al.* disclose “acquiring supplier information concerning at least a time when each of said supplier can supply said service via network [sic].” Column 7, lines 3-6 of Venkatesan *et al.* is reproduced below:

The Database is searched in step (21), preferably automatically, for the single Supplier which can fulfill the Request, by matching Supplier Capability Information and Desired Product Information in the Request.

Applicants fail to see any disclosure, explicit or otherwise, in the above-cited text that states that supplier information is acquired that concerns at least a time when each supplier can supply the desired synthesized strand.

In the September 23, 2005 Final Office Action, the Patent Office alleges that column 8, lines 5-10 of Venkatesan *et al.* disclose “acquiring supplier information concerning at least a time when each of said supplier can supply said service via network [sic].” Column 8, lines 5-10 of Venkatesan *et al.* is reproduced below:

Furthering the process of obtaining the Synthesized Strand, Customer chooses a Selected Supplier from the List via the Network in step (46) and the Selected

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Supplier is informed of the Request via the Network in step (47). Selected Supplier send Confirmation, preferably including current price and shipping information in step (48).

Applicants fail to see any disclosure, explicit or otherwise, in the above-cited text that states that supplier information is acquired that concerns at least a time when each supplier can supply the desired synthesized strand. Furthermore, the above-cited text describes what happens *after* a supplier is selected. There is no teaching or suggestion that the supplier is selected based on the shipping information, since the shipping information is supplied subsequent to a supplier selection.

In the September 23, 2005 Final Office Action, the Patent Office alleges that Figures 1, 2B and 5 of Venkatesan *et al.* disclose “acquiring supplier information concerning at least a time when each of said supplier can supply said service via network [sic].” A careful examination of the cited Figures reveals no disclosure, explicit or otherwise, that would indicate to one of ordinary skill in the art that supplier information is acquired that concerns at least a time when each supplier can supply the desired synthesized strand.

In the Response to Arguments section, the Patent Office completely avoids the thrust of the Applicants’ arguments, choosing instead to argue aspects of Venkatesan *et al.*’s disclosure that are not presently at issue in this application. The Patent Office gives citations to Venkatesan *et al.*’s disclosure regarding customer requests and supplier capabilities, a supplier list of specific services, searching databases that include price, a customer selecting a supplier, the selected supplier sending a confirmation with price and shipping information. Not surprisingly, when faced with the absence in Venkatesan *et al.*’s disclosure regarding the time feature of the Applicants’ invention, the Patent Office bootstraps the disclosure, stating that “as best

understood by the examiner, once price [sic] and shipping information is confirmed [sic] from the selected supplier, customer is expected to meet the timeline that corresponds to acquiring a time when a supplier can supply a particular service.” See pg. 11 of the September 23, 2005 Final Office Action. As a threshold matter, Applicants do not understand why that Patent Office argues that the customer is expected to meet the timeline that corresponds to acquiring a time when a supplier can supply a particular service. Furthermore, the above statement by the Patent Office is simply an attempt to create disclosure where none exists. As noted previously, there is no teaching or suggestion that the supplier is selected based on the shipping information, since the shipping information is supplied subsequent to a supplier selection.

In addition, the Patent Office argues that Venkatesan *et al.* does consider information on when a desired service can be supplied as a supplier selection criterion, and cites column 7, lines 26-29 and 36-39 of Venkatesan *et al.* Column 7, lines 20-39 of Venkatesan *et al.* is reproduced below:

Returning to step (24), if the Limitation is the Lowest Price Supplier, and the current price from the Supplier is higher than the lowest price (e.g. the Supplier has quoted a new, current price higher than the price derived from the Pricing Algorithm and the current price is no longer the lowest price of all Suppliers capable of synthesizing the Request Strand), Database is searched for another Supplier with the Limitation and Supplier Capability Information in step (31). Matching Suppliers are compiled, preferably automatically, into a List in step (32), to which the Customer has been granted access in step (33), preferably automatically. The Customer chooses a Supplier from the List of alternate Suppliers via the Network in step (34). In an effort to receive confirmation from the Selected Supplier, the Selected Supplier is informed, preferably automatically, of the Request via the Network in step (35). The Selected Supplier sends the Confirmation via the Network in step (36), preferably including current price and shipping information, and Customer receives the Confirmation via the Network in step (37).

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Contrary to the Patent Office's assertion that Venkatesan *et al.* discloses that time of providing a service is a selection criterion, Applicants note that the primary selection criterion in the above-cited text is price. In the accompanying flowcharts shown in Figures 3B and 3C, price is the selection criterion. The shipping information, upon which the Patent Office bases its allegation that Venkatesan *et al.* anticipates claim 1, is not sent until *after* the customer chooses a supplier. *See* col. 7, lines 32-33. So, if Venkatesan *et al.* teaches that the shipping information is not sent until after a supplier is selected, how can it be a selection criteria?

To the extent that the Patent Office is making an implicit inherency argument in rejecting claim 1, Applicants remind the Patent Office that the fact that a certain element *may* be present in the prior art is *not* sufficient to establish the inherency of that element. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981). It is clear that Venkatesan *et al.* do not consider information on when a desired service can be supplied to be a supplier selection criterion.

Based on at least the foregoing reasons, Applicants submit that claim 1 is in condition for allowance over Venkatesan *et al.*, and further submit that claim 7 is allowable as well, at least by virtue of its dependency from claim 1. Applicants request that the Patent Office reconsider and withdraw the § 102(e) rejection of claims 1 and 7.

With respect to independent claim 2, Applicants submit that claim 2 is in condition for allowance for at least reasons analogous to those discussed above with respect to claim 1, in that Venkatesan *et al.* fail to teach or suggest at least a step of acquiring a time when a supplier can supply a particular service and selecting a supplier based on at least that criteria. Applicants

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herein incorporate the arguments set forth above with respect to claim 1 as being equally applicable to claim 2. In the Response to Arguments section, the Patent Office's arguments regarding the alleged teachings of Venkatesan *et al.* with respect to claim 2 are traversed for at least reasons analogous to those discussed above with respect to claim 1. Therefore, Applicants submit that claim 2 is allowable, and further submit that claim 8 is allowable as well, at least by virtue of its dependency from claim 2. Applicants request that the Patent Office reconsider and withdraw the § 102(e) rejection of claims 2 and 8.

With respect to independent claim 4, Applicants submit that claim 4 is in condition for allowance for at least reasons analogous to those discussed above with respect to claim 1, in that Venkatesan *et al.* fail to teach or suggest at least a step of acquiring a time when a supplier can supply a particular service and selecting a supplier based on at least that criteria. Applicants herein incorporate the arguments set forth above with respect to claim 1 as being equally applicable to claim 4. In the Response to Arguments section, the Patent Office's arguments regarding the alleged teachings of Venkatesan *et al.* with respect to claim 4 are traversed for at least reasons analogous to those discussed above with respect to claim 1. Therefore, Applicants submit that claim 4 is allowable, and further submit that claims 5 and 9 are allowable as well, at least by virtue of their dependency from claim 2. Applicants request that the Patent Office reconsider and withdraw the § 102(e) rejection of claims 4, 5 and 9.

2. Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Venkatesan *et al.* Applicants respectfully traverse the rejection of claims 3 and 6 for at least the reasons discussed below.

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Since claim 3 depends upon claims 1 and 2, and since the Patent Office does not cite a reference that cures the deficient teachings of Venkatesan *et al.* with respect to claims 1 and 2, Applicants submit that claim 3 is allowable at least by reason of its dependency from claims 1 and 2.

Since claim 6 depends upon claims 4 and 5, and since the Patent Office does not cite a reference that cures the deficient teachings of Venkatesan *et al.* with respect to claims 4 and 5, Applicants submit that claim 6 is allowable at least by reason of its dependency from claims 4 and 5.

Thus, Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 3 and 6.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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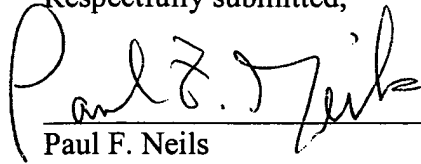
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul F. Neils", written over a horizontal line.

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